

Applicants: Ron S. Israeli et al.
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paragraph, for reasons of record and the following. The Examiner stated that applicant's arguments filed November 16, 1998 have been fully considered but they are not deemed to be persuasive because applicant merely asserts that it is a routine experiment to design an appropriate probe according to the Sambrook textbook chapter provided by applicant.

The Examiner stated that applicant has not provided any evidence or sound scientific reasoning to overcome the grounds of the rejection due to unpredictability and undue experimentation set forth in Paper No. 8, filed May 12, 1998, pages 2-5, which deal with the PSM antigen probe in particular and specific detail.

In response, applicants respectfully traverse the Examiner's position. Applicants contend that undue experimentation would not have been needed to practice the claimed invention. Nevertheless, without conceding the correctness of the Examiner's position but to expedite the prosecution of the subject application, applicants have hereinabove amended the claims such that the nucleic acid is complementary to a nucleic acid sequence, i.e., SEQ ID NO:1. Applicants contend that it is routine for one skilled in the art to design a probe which is complementary to a particular nucleic acid sequence. Applicants contend that one skilled in the art would not need to perform undue experimentation to practice the claimed invention. Applicants contend that these remarks and amendments obviate the above rejection and respectfully request that the Examiner reconsider and withdraw the rejection.

Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 90-93 under 35 U.S.C. § 112, second Paragraph that for reasons of record and the following. The Examiner stated that applicant's arguments filed November 16, 1998

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have been fully considered but they are not deemed to be persuasive because applicant merely asserts that one skilled in the art would know to use the hybridization conditions set forth in a laboratory manual such as the Sambrook textbook chapter provided by applicant.

The Examiner stated that applicant has not provided any evidence or sound scientific reasoning to overcome the grounds of the rejection because "specifically hybridizing" conditions, as set forth in laboratory manuals, vary with the length and nucleotide composition of a particular nucleotide sequence. The Examiner stated that the instant claims do not set forth a fixed length or nucleotide composition of the probe/primer/molecule in the recited methods.

In response, applicants respectfully traverse the Examiner's position. Nevertheless, without conceding the correctness of the Examiner's position but to expedite the prosecution of the subject application, applicants have hereinabove amended the claims such that the claims are drawn to a nucleic acid molecule which is complementary to a particular nucleic acid sequence, i.e. SEQ ID No:1. Applicants contend that one skilled in the art would know how to design a probe which is complementary to this particular nucleic acid sequence. Applicants contend that these amendments and remarks obviate the above rejection and respectfully request that the Examiner reconsider and withdraw the rejection.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone at the number provided below.

Advisory Action

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The September 23, 1999 Advisory Action states that the scope of the claims have changed from all degenerate sequences encoding SEQ ID NO: 2 to a single encoding sequence, SEQ ID NO: 1, which requires a new search and consideration claims. The Advisory Action states that 91-93 and 96 have new matter concerning the combined use of primers that are both fragments of a complementary to SEQ ID NO: 1 (and claim 95 also).

In response, applicants without conceding the correctness of the Examiner's position have hereinabove canceled claims 90-96 without prejudice to their right to pursue the subject matter of these claims in a later-filed application and added new claims 97-102. Applicants contend that this amendment obviates the above rejection and respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Supplemental Information Disclosure Statement

In accordance with their duty of disclosure under 37 C.F.R. §1.56 applicants would like to direct the Examiner's attention to the following references which are listed on the attached Form PTO-1449 (**Exhibit A**) and attached hereto as **Exhibits 1-2**:

1. Kay et al., U.S. Patent 5,852,167, issued December 22, 1998 (**Exhibit 1**) and
2. Wright et al., U.S. Patent 5,153,118, issued October 6, 1992 (**Exhibit 2**).

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone at the number provided

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below.

Summary

For the reasons set forth hereinabove, applicants respectfully request that the Examiner reconsider and withdraw the various grounds for objection and rejection and earnestly solicit allowance of the claims now pending in the subject application.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "John P. White".

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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

John P. White
Reg. No. 28,678

3/20/00
Date